

REMARKS

This is in response to the outstanding Office Action dated July 9, 2007. Applicant had previously cancelled claims 1-4, 6-12, 15-20, and 22-27 and 31 without prejudice or disclaimer. The claims remaining in the application are 5, 13-14, 21, 28-30 and 32-40. Applicant requests reconsideration of the application in light of the following remarks.

In the outstanding office Action, independent Claims 5, 13, 14 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Diamond (4,148,168) in view of the King et al. (6,220,329) and Steiner, Jr. et al. (6,174,403) references. Applicant contends that all the claims are patentable over these references, and requests withdrawal of the rejection under 35 U.S.C. §103(a).

Independent claims 5, 13, 14 and 21 recite a roof covering for application to a roof deck, the roof covering having a laminated starter shingle. The starter shingle includes an underlay sheet laminated below an overlay sheet.

In the outstanding Office Action, the Examiner asserted that the Diamond reference meets all of the limitations of Applicant's independent Claims 5, 13, 14 and 21 with the exceptions of a laminated starter shingle and a laminated starter shingle having exposed portion extending between tabs of the covering shingle. The Examiner further asserted that it would have been obvious to modify the method of Diamond to include the laminated starter strip of King and the laminated layers of differing heights as taught by Steiner.

However, the combination of the Diamond, King and Steiner references does not meet the structure of the invention as claimed in Applicant's independent Claims 5, 13, 14 and 21.

First, the King reference does not disclose a laminated starter strip. Rather, the King reference discloses a three-layer laminated roofing shingle

having a bottom layer (126), a middle layer 124 and a top layer 122 (Column 15, Lines 49-52). The laminated roofing shingles of King are standard covering shingles intended to provide both weather resistance and an attractive appearance. The roofing shingles of King provide an attractive appearance by having multiple layers of tabs with a very random tab configuration (Column 15, Lines 61-66). The roofing shingles of King are intended to be installed in courses over starter shingles.

Second, the three-layer laminated roofing shingle of King cannot be used as a starter strip. A starter strip is a first course of shingles applied along the lower or eave edge of a roof deck before the commencement of the application of standard shingles. The purpose of a starter strip is to provide a base for subsequent courses of covering shingles and to ensure proper weatherproofing of the roof system by sealing gaps beneath the covering shingles. A starter shingle must provide these functions while providing an attractive appearance when installed beneath the covering shingles. The laminated roofing shingles of King include raised portions (148, 150, 152 and 154) and lower portions (136, 138, 140 and 142). In the event the laminated roofing shingle of King is installed as a starter shingle and subsequently covered by a course of covering shingles, the lower portions (136, 138, 140 and 142) would be exposed beneath the course of covering shingles. The exposed lower portions (136, 138, 140 and 142) would form gaps in the roofing system. The gaps would prohibit proper weatherproofing and would provide an unsightly appearance.

Third, the three-layer laminated roofing shingle of King cannot be modified for use as a starter strip. As one skilled in the art can appreciate, there are several standard practices for providing starter shingles. A first practice involves modifying a standard three tab single-layer shingle by cutting the shingles to remove the tabs. The remaining single-layer portion of the shingle is installed as a starter shingle beneath a subsequent course of the standard

three tab single-layer shingles. A second method involves purchasing commercially available starter shingles for use with laminated shingles. The commercially available starter shingles are single-layer shingles that form a weather sealing and appearance enhancing layer beneath the course of subsequent laminated shingles. In order to use the roofing shingle of King, the shingle would have to be cut lengthwise to remove the raised portions (148, 150, 152 and 154). In the event the laminated roofing shingle of King were to be modified to produce a starter shingle by removing the raised portions (148, 150, 152 and 154), the edges of the three layers (126, 124 and 122) would be exposed beneath the course of covering shingles. The exposed edges of the three layers, on such a starter shingle, would provide an unsightly appearance when installed beneath a subsequent course of laminated shingles.

Accordingly, even if the Diamond, King and Steiner references are combined in a light most favorable to the Examiner, the resulting combination does not meet the structure of the invention as claimed in Applicant's independent Claims 5, 13, 14 and 21. A combination of the Diamond, King and Steiner references provides a course of single layer starter shingles covered by offset covering shingles of Diamond, the covering shingles being laminated and having variations of tab configurations of King, and the laminated shingles having layers of various heights of Steiner. However, the combination of Diamond, Steiner and King fails to show a roof covering applied to a roof deck, the roof covering having a laminated starter shingle, wherein the laminated starter shingle includes an underlay sheet laminated below an overlay sheet as claimed in Applicant's independent claims 5, 13, 14 and 21.

It is well established that all claim limitations must be taught or suggested by the prior art. As set forth in the MPEP, at least at §2143.03, in order to establish *prima facie* obviousness of a claimed invention, all of the claimed limitations must be taught or suggested by the prior art, citing *In Re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In this regard, Applicant's

independent Claims 5, 13, 14 and 21 are non-obvious under 35 U.S.C. §103 in view of Diamond, Steiner and King. Therefore, the rejection of Claims 5, 13, 14 and 21 are improper and the claims are patentable as written.

Claims 28-30 depend from Claim 5 and should be patentable for at least the same reasons as Claim 5, as set forth above.

Claims 32-33 depend from Claim 13 and should be patentable for at least the same reasons as Claim 13, as set forth above.

Claims 34-35 depend from Claim 14 and should be patentable for at least the same reasons as Claim 14, as set forth above.

Claims 36-40 depend from Claim 21 and should be patentable for at least the same reasons as Claim 21, as set forth above.

In view of the above remarks, the Applicant has shown that the claims are in proper form for allowance, and the invention, as defined in claims 5, 13-14, 21, 28-30 and 32-40, is neither disclosed nor suggested by the references of record. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the rejections of record, and allowance of all claims.